

1628
PATENT

Customer No. 22,852

Attorney Docket No. 07579.0014-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HEATON et al.

Application No.: 09/889,701

Filed: November 5, 2001

For: PRODUCTION OF ISOFLAVONE
DERIVATIVES

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)
) Group Art Unit: 1626
)
) Examiner: Golam M. Shameem
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)
)
)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(d)

Pursuant to 37 C.F.R. § 1.56, Applicants bring to the attention of the Examiner the documents listed on the attached Form PTO 1449. This Information Disclosure Statement is being filed after the mailing date of a Final Action. Nonetheless, Applicants respectfully request that the Examiner waive the rule and kindly consider this Information Disclosure Statement because of the Examiner's familiarity with this case and its related co-pending cases. If the Examiner declines to consider these references, Applicants respectfully request that these papers be placed in the file pursuant to 37 C.F.R. § 1.97(i). Should the Examiner kindly consider this Information Disclosure Statement, Applicants authorize the Office to deduct the fee of \$180.00 as specified by 37 C.F.R. § 1.17(p) from our Deposit Account No. 06-0916.

These documents, as summarized in the chart below, are U.S. Patents and U.S. applications that are possibly related to the pending application by subject matter.

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01/13/2004 AWDNDAF 00000044 060916 09889701

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U.S. Patent or Application Number	Attorney Docket Number	Title	Examiner
09/602,191	07579.0001-00000	Health Supplements Containing Phyto-Oestrogens, Analogues or Metabolites Thereof	Patrick T. Lewis
6,146,668	07579.0003-00000	Preparation of Isoflavones from Legumes	
09/546,565	07579.0003-01000	Isoflavone Compositions Produced by Improved Methods	Deborah K. Ware
6,562,380 B1	07579.0005-00000	Method for Treating or Reducing Predisposition to Breast Cancer , Pre-Menstrual Syndrome or Symptoms Associated with Menopause by Administration of Phyto-Estrogen	
6,497,906 B1	07579.0005-01000	Dietary Supplements Comprising Soy Hypocotyls Containing at Least One Isoflavone	
6,642,212 B1	07579.0005-02000	Health Supplements Containing Phyto-Oestrogens, Analogues or Metabolites Thereof	
10/274,371	07579.0005-03000	Dietary Supplements Comprising Soy Hypocotyls Containing At Least One Isoflavone	Patrick T. Lewis
10/611,087	07579.0005-04000	Health Supplements Containing Phyto-Oestrogens, Analogues or Metabolites Thereof	Not Yet Assigned
10/611,151	07579.0005-05000	Health Supplements Containing Phyto-Oestrogens, Analogues or Metabolites Thereof	Not Yet Assigned
6,340,703	07579.0006-00000	Treatment or Prevention of Osteoporosis	
09/986,509	07579.0006-01000	Treatment or Prevention of Menopausal Symptoms	Edward J. Webman

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U.S. Patent or Application Number	Attorney Docket Number	Title	Examiner
6,649,648 B1	07579.0007-00000	Therapeutic Methods and Compositions Involving Isoflavones	
10/176,762	07579.0007-01000	Therapeutic Methods and Compositions Involving Isoflavones	Jennifer M. Kim
10/177,387	07579.0007-02000	Therapeutic Methods and Compositions Involving Isoflavones	Jennifer M. Kim
10/636,902	07579.0007-03000	Therapeutic Methods and Compositions Involving Isoflavones	Jennifer M. Kim
6,004,558	07579.0008-00000	Methods for Treating Cancer with Legume Plant Extracts	
6,455,032 B1	07579.0012-00000	Composition and Method for Protecting Skin from UV Induced Immunosuppression and Skin Damage	
10/212,847	07579.0012-01000	Composition and Method for Protecting Skin from UV Induced Immunosuppression and Skin Damage	Shelley Dodson
6,599,536 B1	07579.0013-00000	Therapy of Estrogen-Associated Disorders	
10/459,537	07579.0013-01000	Therapy of Estrogen-Associated Disorders	Not Yet Assigned
09/889,701 (the instant application)	07579.0014-00000	Production of Isoflavone Derivatives	Golam M. Shameem
10/600,004	07579-0015-01000	Cardiovascular And Bone Treatment Using Isoflavones	Not Yet Assigned

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U.S. Patent or Application Number	Attorney Docket Number	Title	Examiner
10/704,385	07579.0016-01000	Compositions and Therapeutic Methods Involving Isoflavones and Analogs Thereof	Not Yet Assigned
10/181,549	07579.0017-00000	Food Product and Process	Not Yet Assigned
10/250,858	07579.0018-00000	Regulation of Lipids and/or Bone Density and Compositions Therefore	Not Yet Assigned
10/469,957	07579.0019-00000	Dimeric Isoflavones	Not Yet Assigned
10/471,668	07579.0020-00000	Treatment of Restenosis	Not Yet Assigned

To facilitate the Examiner's review of these documents and avoid the wasteful reproduction of specifications, Applicants submit only the claims issued or pending in cases based on the same original specification (namely, documents related to U.S. Patent No. 5,830,887, i.e. U.S. patent applications Nos. 09/602,191, 10/274,371; 10/611,087; 10/611,151; documents related to U.S. patent No. 6,340,703, i.e. U.S. patent application No. 09/986,509; documents related to U.S. Patent No. 6,649,648 B1, i.e. U.S. Patent Applications Nos. 10/176,762; 10/177,387; 10/636,902; documents related to U.S. Patent No. 6,146,668, i.e. U.S. Patent Application No. 09/546,565; documents related to U.S. Patent No. 6,455,032 B1, i.e. U.S. Patent Application No. 10/212,847; and documents related to U.S. Patent No. 6,599,536 B1, i.e. U.S. Patent Application No. 10/459,537). For documents that are not based on the same specification, Applicants provide the specifications. For U.S. Patent Application No. 10/181,549 Applicants provide both specification as filed and a set of pending claims. Should the Examiner wish to see copies of any documents not provided here, please advise the undersigned at the number below.

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Applicants respectfully request that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form. Should the Examiner conclude that any of these claims form the basis of a rejection, the Examiner is invited to contact the undersigned.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and Applicants determine that the cited documents do not constitute "prior art" under United States law, Applicants reserve the right to present to the Office the relevant facts and law regarding the appropriate status of such documents.

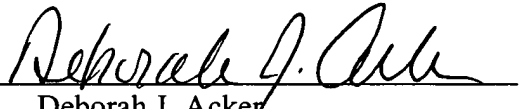
Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 8, 2004

By: 
Deborah J. Acker
Reg. No. 48,916

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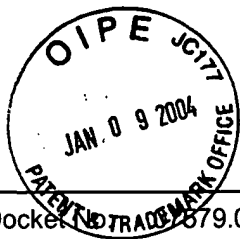


INFORMATION DISCLOSURE CITATION

Atty. Docket No. 9.0014-00000	Appln. No. 09/889,701
Applicant HEATON et al.	
Filing Date November 5, 2001	Group: 1626

U.S. PATENT DOCUMENTS						
Examiner Initial*	Document Number	Issue Date	Name	Class	Sub Class	Filing Date If Appropriate
	6,004,558	Dec. 21, 1999	THURN et al.			Feb. 25, 1998
	6,146,668	Nov. 14, 2000	KELLY et al.			Apr. 27, 1997
	6,340,703	Jan. 22, 2002	KELLY			Jun. 2, 1998
	6,455,032 B1	Sep. 24, 2002	KELLY et al.			Jun. 23, 2000
	6,497,906 B1	Dec. 24, 2002	KELLY			Apr. 11, 2000
	6,562,380 B1	May 13, 2003	KELLY			Aug. 13, 1997
	6,599,536 B1	Jul. 29, 2003	KELLY et al.			Dec. 5, 2000
	6,642,212 B1	Nov. 4, 2003	KELLY			Oct. 19, 1999
	6,649,648 B1	Nov. 18, 2003	KELLY et al.			Aug. 5, 1999
	09/546,565 (pending claims)		KELLY et al.			Apr. 11, 2000
	09/602,191 (pending claims)		KELLY			Jun. 22, 2000
	09/986,509 (pending claims)		KELLY			Nov. 9, 2001
	10/176,762 (pending claims)		KELLY et al.			Jun. 21, 2002
	10/177,387 (pending claims)		KELLY et al.			Jun. 21, 2002
	10/181,549 (WO 01/53285; pending claims)		Husband et al.			Nov. 7, 2002
	10/212,847 (pending claims)		KELLY et al.			Aug. 5, 2002

Examiner	Date Considered
<p>*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</p>	
Form PTO 1449	Patent and Trademark Office - U.S. Department of Commerce



OMB No. 0651-0011

INFORMATION DISCLOSURE CITATION

Atty. Docket No. 0679.0014-00000	Appln. No. 09/889,701
Applicant HEATON et al.	
Filing Date November 5, 2001	Group: 1626

U.S. PATENT DOCUMENTS						
Examiner Initial*	Document Number	Issue Date	Name	Class	Sub Class	Filing Date If Appropriate
	10/250,858 (WO 02/055072)		Husband			Jul. 9, 2003
	10/274,371 (pending claims)		KELLY			Oct. 21, 2002
	10/459,537 (pending claims)		KELLY et al.			Jun. 12, 2003
	10/469,957 (WO 02/070502)		Husband et al.			Sep. 8, 2003
	10/471,668 (WO 02/074307)		Husband et al.			Sep. 15, 2003
	10/600,004 (WO 00/64438)		KELLY et al.			Jun. 18, 2003
	10/611,087 (pending claims)		KELLY			Jul. 2, 2003
	10/611,151 (pending claims)		KELLY			Jul. 2, 2003
	10/636,902 (pending claims)		KELLY et al.			Aug. 6, 2003
	10/704,385 (WO 01/17986)		HEATON et al.			Nov. 7, 2003

Examiner	Date Considered
<p>*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</p>	
Form PTO 1449	Patent and Trademark Office - U.S. Department of Commerce